

**O-331-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**INTERNATIONAL REGISTRATION NO. 1205461**

**IN THE NAME OF**

**LEONICE SOCIETE ANONYME TRADING AND MANUFACTURING  
COMPANY OF VARNISHES AND PAINTS**

**TO REGISTER:**

**ECOTINT**

**IN CLASS 2**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 402908 BY EWALD DÖRKEN AG**

## BACKGROUND

1. On 11 April 2014, Leonice Societe Anonyme Trading and Manufacturing Company of Varnishes and Paints (“the applicant”) requested protection in the United Kingdom of the International Registration (“IR”) of the trade mark shown on the cover page of this decision. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 20 June 2014 for the following goods in class 2:

Paints; varnishes; lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

2. The designation of the IR is opposed by Ewald Dörken AG (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition, which is directed against all of the goods in the IR, is based upon the goods and services (shown below) in the following Community Trade Mark (“CTM”) registrations:

CTM no. 9911439 for the trade mark: **DecoTint** which was applied for on 20 April 2011 and which completed its registration process on 11 January 2012:

**Class 2** - Paints, varnishes, lacquers, colorants; Preservatives against rust and against deterioration of wood; Colorants; Mordants; Raw natural resins; Metals in foil and powder form for painters, decorators, printers and artists; Wood protection glazes; UV-resistant paints, varnishes, lacquers; Wood preservatives; Wood stains; UV-resistant chemical paints; Semi-finished goods, namely colouring pastes being paints or colorants for colour-mixing installations, colouring pastes being paints or colorants for industrial manufacturing.

**Class 40** - Treatment of materials, mixing paints and lacquers, for others, using colour-mixing systems.

**Class 42** - Colorimetry services for paste systems and colouring systems, in particular creating colour-matching sequences and formulation of colour tones and colour tone collections.

CTM no. 4429593 for the trade mark:

The logo for DecoTint, featuring the word "DecoTint" in a stylized, bold, sans-serif font. The letters are white with a thick black outline, giving it a 3D or embossed appearance. The "T" is particularly prominent with its sharp, angular top.

which was applied for on 9 May 2005 (claiming an International Convention priority date of 12 November 2004 from an earlier filing in Germany) and which completed its registration process on 17 May 2006.

**Class 2** - Tinging pastes being paints or dyes; semi-finished products, namely tinging pastes being paints or dyes for color mixing facilities, tinging pastes being paints or dyes for the industrial manufacture.

3. In its Notice of opposition, the opponent states:

“The marks differ by only one letter, with the applicant’s trade mark being wholly contained in the opponent’s earlier trade mark. They share the same seven letters in the same order. Therefore, the marks are visually similar. Phonetically the trade marks are highly similar as they contain the same suffix -TINT, the prefixes being pronounced in a similar manner i.e. DECO-TINT v ECHO-TINT. Alternatively, the marks could be pronounced as DEECO-TINT vs. EECO-TINT, which again, are highly similar.”

Having noted that, inter alia, the goods in class 2 of CTM no. 9911439 are identical to those in the application, the opponent further argues that the goods relied upon in CTM no. 4429593 “are identical or highly similar” to those contained in the application.

4. The applicant filed a counterstatement in which it admits that its goods are “identical or similar to those protected under the opponent’s trade mark”. It states:

“However, we do not agree that the trade marks at issue are similar.

We agree that the trade marks at issue differ by one letter and that they share the same seven letters in the same order but we are of the view that the addition of the letter “D” at the beginning of the opponent’s trade mark makes a significant difference such as to be able to distinguish between the trade marks at issue.

The word TINT being the final four letters (word) of each of the trade marks must be considered descriptive, and generic in respect of the goods involved.

As such, users of the goods will tend to concentrate on the prefixes of the trade marks and in this respect they are dissimilar.

The prefix ECO of the [IR] has many meanings but in relation to the goods to be protected will be seen as the well known term relating to “ecological and environmental matter”. It is normally pronounced as E-CO.

On the other hand the prefix DECO...is likely to be seen as the shortened form of ART DECO, the DECO element pronounced as DECK-O, and having a considerably different meaning to the ECO prefix.”

5. Although neither party filed evidence, the applicant filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing. I will keep all of these submissions in mind and refer to them, as necessary, later in this decision.

## DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“5 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As CTM no. 9911439 had not completed its registration process more than 5 years before the publication date of the IR in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified. Although CTM no. 4429593 is, in principle, subject to the proof of use provisions, as the applicant indicated in its counterstatement that it did not want the opponent to provide proof of use, the opponent can rely upon the goods I have identified above.

### **Section 5(2)(b) – case law**

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales*

*Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

**The opponent’s best case**

10. In these proceedings, the opponent is relying upon the two earlier trade marks mentioned above. Although the applicant has not put the opponent to proof of use, as the opponent’s CTM no. 9911439 consists of the same elements present in CTM no. 4429593 (but which are presented in normal type face) and as it contains a broader range of goods and services, it is this trade mark I shall use for the purposes of comparison. If the opponent does not succeed in relation to this trade mark, it will be in no better position in relation to its other earlier trade mark.

**Comparison of goods and services**

11. The competing goods and services are as follows:

<b>Opponent’s goods and services being relied upon – CTM no. 9911439</b>	<b>Applicant’s goods</b>
<p><b>Class 2</b> - Paints, varnishes, lacquers, colorants; Preservatives against rust and against deterioration of wood; Colorants; Mordants; Raw natural resins; Metals in foil and powder form for painters, decorators, printers and artists; Wood protection glazes; UV-resistant paints, varnishes, lacquers; Wood preservatives; Wood stains; UV-resistant chemical paints; Semi-finished goods, namely colouring pastes being paints or colorants for colour-mixing installations, colouring pastes being paints or colorants for industrial manufacturing.</p> <p><b>Class 40</b> - Treatment of materials, mixing paints and lacquers, for others, using colour-mixing systems.</p> <p><b>Class 42</b> - Colorimetry services for paste systems and colouring systems, in particular creating colour-matching sequences and formulation of colour tones and colour tone collections.</p>	<p><b>Class 2</b> - Paints; varnishes; lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.</p>

12. Although the opponent also relies on services in classes 40 and 42, as its specification in class 2 includes all of the goods in the application, the competing goods are identical.

## The average consumer and the nature of the purchasing act

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14. In its submission, the applicant states:

“...as well as the fact that the average consumer, in this case the general public, is likely to be very attentive when purchasing goods of the nature of the goods in question...”

and:

“The goods are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues...”

In its submissions, the opponent states:

“33. The opponent agrees that the relevant consumer of the respective goods is the UK general public...”

34. The opponent therefore disagrees with the applicant's assertion that the relevant public in this case will be very attentive when purchasing the goods...the opponent does not believe that the goods are such that the consumer would exhibit a higher degree of attention when purchasing them...”

15. I agree that the average consumer of the goods at issue will include the general public, but it will also include tradesmen and women using such goods as part of their everyday business activities. Such goods are, I also agree, most likely to be selected on the basis the applicant suggests, indicating that visual considerations will be an important part of the selection process. However, as a member of the public may also seek advice from, for example, a sales assistant in a home improvement store or, in the case of a tradesperson, from an assistant in a wholesaler or trade outlet, aural considerations must not be lost sight of, although they will, in my view, be a less

important part of the process. Although the cost of the goods at issue is unlikely to be high, the frequency with which such goods are likely to be purchased by a member of the general public, combined with the need for such a consumer to ensure, for example, that the goods have the correct characteristics (ingredients, colour, longevity etc.) points, in my view, to a member of the general public paying at least an average degree of attention during the purchasing act. Although a tradesperson is likely to be much more familiar with the goods at issue and their characteristics and will be purchasing them on a more regular basis, as the quantities purchased (and the resultant cost) are likely to be higher, and as a tradesperson will need to ensure that its client's requests are met, suggests that they too will pay at least an average degree of attention during the selection process.

**Comparison of trade marks**

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

17. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
DecoTint	<b>ECOTINT</b>

18. In its submissions, the applicant states:

“It is clear that the trade marks involved do not lend the consumer to separate them into different components; the respective overall impressions are based solely on the totality of which they consist.”

and:

“However, it should not be ignored that the word element TINT must be considered as completely descriptive and lacking in distinctive character in respect of goods in class 2.

As such, and whilst the respective trade marks should be considered in totality, in this instance it is the prefixes “ECO” and “Deco” which are more likely to have more of an overall impact to the average consumer, and are the elements more likely to have an overall lasting impact to the consumer...”

In its submissions, the opponent states:

“29. The opponent agrees with the applicant that ECO does have a meaning “denoting ecology or ecological” and that DECO can relate to the Art Deco movement i.e. a style of interior decoration. The opponent also agrees with the applicant that the second element TINT has a meaning which is identical in each case. However, the opponent also agrees with the applicant when they argue [as paragraph 18 first quotation]. In addition, the very acceptance of these trade marks indicates that the average consumer would see them as a whole which is more than the sum of their parts...”

19. Notwithstanding the parties’ submissions, in my view, the fact that the word “Deco” in the opponent’s trade mark is followed by a capital letter “T”, serves to break it up into two distinct elements i.e. the words “Deco” and “Tint” and this is, in my view, the overall impression it will create. In its submissions, the opponent accepts that the word “Deco” can relate to the Art Deco “style of interior decoration”. In addition, it does not deny the applicant’s submissions to the effect that in relation to the goods at issue, the word “Tint” is descriptive and non-distinctive. That appears to me to be a sensible position to adopt given that collinsdictionary.com defines “tint” as, inter alia, “a shade of a colour, esp a pale one”, “a colour that is softened or desaturated by the addition of white”, “a tinge”. Despite consisting of two distinct elements, neither is, in my view, dominant, the distinctiveness lying in the totality.

20. As the applicant’s trade mark is presented as one word in a bold but unremarkable font with all of the letters appearing in upper case, it has no distinctive and dominant elements. However, it will not, in my view, go unnoticed that it consists of a combination of words with which the average consumer will be very familiar i.e. ECO and TINT; as a consequence, this is the overall impression it will create. As the words ECO and TINT are descriptive and non-distinctive, like the opponent’s trade mark, the distinctiveness lies in the totality created.

21. Having reached those conclusions, I must now compare the competing trade marks from the visual, aural and conceptual perspectives. Although it is this issue which dominated the parties’ submissions, I do not intend to include those submissions here.

For the avoidance of doubt, however, I have considered all the parties' submissions in reaching the conclusions I have.

22. The competing trade marks consist of seven and eight letters respectively (seven of which are identical and appear in the same order in both trade marks). They differ to the extent that the opponent's trade mark also contains the letter "D" as the first letter, the letter "T" in the opponent's trade mark is capitalised and the applicant's trade mark is presented in a bold font. The competing trade marks are visually similar to a fairly high degree. As to how the competing trade marks will be pronounced, the parties have offered a range of possibilities. The opponent suggests that its trade mark may be pronounced as either DECK-O-TINT or DEE-CO-TINT and the applicant's trade mark as ECK-O-TINT or EEE-CO-TINT, whereas the applicant suggests its trade mark will be pronounced as EECO-TINT or E-CO-TINT with the opponent's trade mark being pronounced as DEC/DECK-O-TINT. As all of the elements of which the competing trade marks are made up will be well known to the average consumer, their pronunciations are, in my view, fairly predictable, with the competing trade marks most likely to be articulated in the manner the applicant suggests. However, I agree with the opponent that irrespective of how the competing trade marks are actually pronounced, they both consist of three syllables "where the syllables have an identical or very similar length". Notwithstanding the difference at the start of the competing trade marks, they are still, in my view, aurally similar to a fairly high degree.

23. Finally, in relation to conceptual similarity, the applicant states:

"...it is quite clear they evoke different meanings."

In its submissions, the opponent states:

"28...the marks are neologisms, neither of which has any clear meaning..."

and:

"30. The opponent therefore contends that it is not clear, as the applicant asserts, that the respective marks will portray different meanings...the opponent contends that the respective marks would not be artificially broken down such that consumers would not ascribe any meaning to them."

24. Given the conclusions I have reached above, the applicant's position is to be preferred. Whilst the inclusion of the word Tint/TINT in both parties' trade marks will evoke identical conceptual imagery, in relation to the goods at issue, that imagery is descriptive. However, when considered as totalities, the applicant's trade mark will, in my view, create a concrete image of goods with ecological or environmental qualities for use as tints or in tinting. Whilst the conceptual message created by the opponent's trade is less precise (decorative tints or tints to produce an art deco style perhaps), it is unarguable that the concept of environmental considerations is entirely absent from it.

## **Distinctive character of the earlier trade mark**

25. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. I have already concluded that the component parts of the opponent's trade mark are descriptive and non-distinctive. When considered as a whole, its clear suggestive qualities results in it being possessed of a lower than normal degree of inherent distinctive character.

## **Likelihood of confusion**

26. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- CTM no. 9911439 represented the opponent's best case;
- the competing goods are identical;
- the average consumer is either a member of the general public or a tradesperson who will select the goods by a mixture of visual and aural means, with visual considerations likely to dominate the process;
- the average consumer will pay at least an average degree of attention during the purchasing act;
- the competing trade marks have no distinctive or dominant components, the overall impression they convey resulting from the identifiable elements of which they are made up;
- the competing trade marks are visually and aurally similar to a fairly high degree;

- when considered as wholes, the applicant's trade mark will send a concrete conceptual message which will not be conveyed by the opponent's trade mark;
- the opponent's earlier trade mark is possessed of a lower than normal degree of inherent distinctive character.

27. The fact that the opponent's trade mark has only a lower than normal degree of inherent distinctive character does not preclude a likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

28. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

29. In *Nokia Oyj v OHIM*, Case T-460/07, the General Court ("GC") stated that:

"Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98)."

In its submissions, the opponent states:

“31. All things considered, the opponent contends that the aural and visual aspects of each mark overpower any concept underlying the marks.”

30. I begin by reminding myself that the competing goods are identical, the average consumer will pay at least an average degree of attention when selecting the goods, the goods will be selected by predominately visual means and the competing trade marks are, inter alia, visually and aurally similar to a fairly high degree. Notwithstanding those conclusions, the clear conceptual message that will, in my view, be conveyed by the applicant's trade mark is, as the concept of ecological or environmental qualities is entirely absent from the opponent's trade mark, sufficient, despite the opponent's submissions to the contrary, to counteract the visual and aural similarities I have identified. As a consequence, there is, in my view, no likelihood of either direct or indirect confusion.

31. In reaching the above conclusion I have not overlooked (i) the earlier decisions of the UK IPO referred to by the opponent or (ii) the fact that the opponent has successfully opposed the applicant's trade mark in other jurisdictions i.e. Spain, Ireland and Austria. In this regard, I have not found the decisions of the UK IPO (one of which was my own) to be of particular assistance, nor are the decisions from other jurisdictions (which are rarely of assistance), particularly where language considerations may have been a relevant factor.

### **Overall conclusion**

32. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

### **Costs**

33. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent's statement:	£200
---	------

Written submissions:	£200
----------------------	------

<b>Total:</b>	<b>£400</b>
---------------	-------------

34. I order Ewald Dörken AG to pay to Leonice Societe Anonyme Trading and Manufacturing Company of Varnishes and Paints the sum of **£400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16th day of July 2015**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**